

REMARKS

Claims 1-9, 12-19, 21, 23, 24, 53 and 72-74 are pending in the application. Claims 1, 12 and 52 remain as independent claims. It is believed that the remarks presented herein below address each of the Examiner's rejections of the claims.

Claim Rejection – 35 U.S.C. §103

The Examiner has rejected claims 1-9, 12-19, 21, 23, 24 and 52 under 35 U.S.C. §103(a), as being unpatentable over US Patent 7,111,230 to Euchner et al, hereinafter "Euchner," in view of US Patent 6,915,281 to Coffy et al., 6,915,281, hereinafter "Coffy."

The Examiner has rejected claims 72-74 under 35 U.S.C. §103(a), as being unpatentable over Euchner in view of Coffy further in view of US Patent 7,050,181 to Korst et al., hereinafter "Korst."

Applicant respectfully disagrees with and traverses these rejections.

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007):

"Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented." Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP §2143.03, to ascertain the differences between the prior art and the claims at issue, "[a]ll claim limitations must be considered" because "all words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the aforementioned *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) "Obvious to try"—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, 82 USPQ2d 1385 (2007).

In accordance with the above provisions, a review of the cited references Euchner, Coffy and Korst is therefore in order.

Euchner, as its title suggests, clearly teaches a system and method for annotating documents. Euchner provides multiple examples and description for how various people are provided with copies of a master document and each person's edits to the master document are then tracked and recorded.

Euchner clearly and unambiguously teaches repeatedly that **the same printer is used to print the digital paper (digital pattern) AND the document.** This point is stated no less than three times.

"A special printer is used to print both the digital paper and the document so that the electronic master document is associated with the printed hardcopy. The printer prints a digital paper identifier such as a carbon based dot pattern to provide a unique pattern space. The printer also prints the hardcopy document on the paper so that the electronic version of the document is associated with that particular pattern space." Col. 2, lines 24-31, emphasis added.

"In an illustrative embodiment, a special printer is used to print both the digital paper and the document so that the electronic master document is associated with the printed hardcopy." Col. 4 lines 38-41, emphasis added.

"In another alternative, a bitmap printer such as a laser printer or an inkjet printer is utilized to print both an underlying ANOTO pattern and a document." Col. 7, lines 59-60, emphasis added.

The Examiner has cited to Col 5, lines 14-16 to support the contention that the digital paper may be pre-printed. A review of this section is indeed informative.

"Printer 110 may concurrently encode paper 120 with digital pattern information when printing the hardcopy documents 125. Alternatively, paper 120 may be preprinted with digital pattern information and the paper is associated with the document.

In this system, **a special printer 110** prints multiple hardcopies 125 of the original version of the document." Col 5, lines 12-18, emphasis added.

Euchner has specifically stated that it is A SPECIAL PRINTER that prints the digital pattern **and** the document. That Euchner states the digital pattern may be preprinted is not disputed, however based on the teachings set forth it must be undisputed as well that whether preprinted or not Euchner clearly and unambiguously teaches that it is **the same printer**. Whether the digital pattern and document are printed concurrently or the digital pattern is preprinted and the document then added, it is **the same printer performing both tasks**.

Euchner does not teach the digital pattern being provided by a first printer and the content being provided by a second printer. As Euchner fails to teach a first and second printer, Euchner also fails to teach transferring a machine-readable identity code between the second printer and the printed sheet at around the time of printing the content.

Coffy quite clearly teaches a system and method for using a digital pen for funds accounting devices and postage meters. Coffy teaches that the envelope has pre-printed embedded intelligence that can be read by the pen. Col 5, lines 1-10. Coffy further teaches that the pen is used by a user to write upon the envelope so as to indicate an address, class of postage and amount of intended postage. Coffy does not teach a second printer. As Coffy fails to teach a first and second printer, Coffy also fails to teach transferring a machine-readable identity code between the second printer and the printed sheet at around the time of printing the content.

The pen is described as having a processor and components enabling it to detect position and/or BIODATA – as a pen any and all ability to provide a mark is achieved by a human operator manipulating the pen in the exercise of drawing or writing. This pen as taught by Coffy is not equivalent to the second printer as set forth in the present application, and Examiner is in error to do so. To remove the pen and substitute a printer would clearly frustrate the purpose and teaching of Coffy as the human user would not be able to use a second printer in the same manner as a pen.

With respect to the references of Euchner and Coffy, the Examiner asserts that they are combinable simply because they each teach editing a hardcopy of a document through the use of an electronic pen. Whether or not Euchner and Coffy teach editing document with a pen is somewhat irrelevant. Both Euchner and Coffy teach a printer – *not two printers*. Coffy does not undo the specific teaching of Euchner to use **the same printer for providing both the digital pattern and the hardcopy document**. As neither Euchner nor Coffy teach the use of two printers, Euchner and Coffy when combined also fail to teach transferring a machine-readable identity code between the second printer and the printed sheet at around the time of printing the content.

Korst is a printer application adapter system. Korst teaches how old legacy printers, for example dot matrix printers, requiring the specification of "DARK" when bold printing is desired can be used by a system that provides "BOLD" as the darkening command by recognizing the unsupported command and replacing it with a legacy command. More specifically, Korst teaches how a data stream directing "PRINT BOLD 'HELLO'" that would be unintelligible to the legacy printer becomes "PRINT DARK 'HELLO'" by replacing the unknown command.

Korst teaches nothing whatsoever regarding the use of two printers, let alone one printer to provide a digital pattern and a second printer to provide human-discernable content. As Korst fails to teach a first and second printer, Korst also fails to teach transferring a machine-readable identity code between the second printer and the printed sheet at around the time of printing the content. At best Korst might be adapted to help control the second printer (e.g. a legacy printer) in the present invention, but even with such adaptation, Korst can in no way be found to teach the first and second printers or the transfer of machine-readable identity code between the second printer and the printed sheet at around the time of printing the content.

In light of the above summary of Euchner, Coffy and Korst it is respectfully submitted that the Examiner has failed to resolve the *Graham* factual inquiries by failing to properly ascertain the actual differences between the prior art references of Euchner and Coffy and at the very least claim 1, 12 and 52. Korst as added with respect to dependent claims 72-74 in no way resolves these actual differences.

Although other differences certainly exist, these are critical to the teachings of Euchner and Coffy and cannot be ignored. Indeed a large number of devices may exist in the prior art where, if the prior art is disregarded as to its content, purpose, mode of operation and general context, the several elements claimed by the Applicant, if taken individually, may be disclosed. However, the important thing to recognize is that the reason for combining these elements in any way to meet

Applicant's claims only becomes obvious, if at all, when considered from hindsight in the light of the application disclosure. The Federal Circuit has stressed that the "decisionmaker must step backward in time and into the shoes worn by a person having ordinary skill in the art when the invention was unknown and just before it was made." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566 (Fed. Cir. 1987). Therefore, if the above-identified criteria are not met, then the cited reference(s) fails to render obvious the claimed invention and, thus, the claimed invention is distinguishable over the cited reference(s). Respectfully, the March 26, 2008 Office Action has failed to meet this burden.

The guidelines under KSR echo this point, and evidence how and why Examiner's view of obviousness from the combination of references is unfounded.

For a combination of references to be proper there must be:

1 - a finding that the prior art included each element claimed with the only difference between the claimed invention and the prior art being the lack of actual combination.

This is not done – The claims of the present application clearly assert that there are two printers – one providing the pattern and a second providing content and in certain embodiments an identity code. Euchner does not teach two printers. Euchner clearly and unambiguously teaches that, "***special printer is used to print both the digital paper and the document*** so that the electronic master document is associated with the printed hardcopy." Col 4, line 38-41. Coffy likewise teaches only one printer. Whether or not Euchner and Coffy teach editing of a hardcopy document is irrelevant and does not undo the specific teachings of Euchner for a single special printer.

As neither Euchner nor Coffy teach the use of two printers, Euchner and Coffy when combined also fail to teach transferring a machine-readable identity code between the second printer and the printed sheet at around the time of printing the content. Indeed, Euchner and Coffy fail to provide at least two (2) elements claimed in the present invention.

Moreover, all of the claimed elements are not shown and the only difference is clearly not the lack of actual combination.

2 – a finding that one of ordinary skill in the art could have combined the elements as claimed by known methods, and that in combination, each element merely would have performed the same function as it did separately.

This is not so – Euchner and Coffy fail to provide all of the elements as presented by Applicant. At least one missing element is a distinct first printer printing the digital pattern upon the paper and a distinct second printer printing human discernable content upon the pre-printed paper. At least another missing element is transferring a machine-readable identity code between the second printer and the printed sheet at around the time of printing the content.

Spontaneous acquisition of missing elements is certainly not disclosed, and known methods as applied to the Euchner and Coffy disclosed elements would not provide them.

3 – a finding that one of ordinary skill in the art would have recognized that the results of the combination were predictable.

This is not so - The modifications required to Euchner and Coffy are so significant and contrary to the teachings, that the results are in no way predictable.

4 – any additional findings.

Respectfully, as the Examiner has mischaracterized the references and the associated differences with the present invention. Examiner's statement of "official notice" that the printer doing the printing of the pattern would have better resolution than the second printer is unfounded. There is simply no sustainable inference for a second printer let alone that the second printer would have lesser, greater or equal printing resolution. Only in the present application is the issue of the second printer specifically realized and that the second printer may have lesser resolution – e.g., a legacy or existing printer already in the workplace environment that would have to be replaced for the specialized printer as taught by Euchner. Further still, Korst offers nothing to resolve any of the above-identified factual differences. Indeed the mere fact that Korst presents a way of maintaining use of legacy printing equipment is no more an appropriate basis for combination than is the mere fact that Euchner and Coffy teach the use of a digital pen.

Respectfully, **"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the reference are not sufficient to render the claims prima facie obvious."** *In re Ratti* 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (comment added). Euchner specifically teaches a special printer providing both the pattern and the content. Coffy clearly teaches the pattern to be provided by a printer and then the pen to be used by a human operator to provide additional information and the pen is not and cannot be interchanged with the second printer as set forth in the present application.

Without some reason in the references to combine the cited prior art teachings, with some rational underpinnings for such a reason, the Examiner's conclusory statements in support of the alleged combination fail to establish a prima facie case for obviousness. See, *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. ____ (2007) (obviousness determination requires looking at "whether there was an apparent reason to combine the known elements in the fashion claimed...", citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness," *KSR* at 14).

As the *Graham* factual inquiry is not properly resolved, application of any of the rationales (A)-(G) as set forth in the guidelines is futile for Euchner and Coffy, with or without Korst, fail to provide all of the claim elements as set forth in claims 1, 12 and 52, let alone these claims with their respective dependent claims.

More specifically, because the Examiner has failed to ascertain the actual differences between Euchner, Coffy and Korst and the presently described and claimed invention, Examiner's conclusion that Euchner, Coffy and Korst make obvious all of the features as recited in these claims is in error.

Respectfully, withdrawal and allowance of claims 1-9, 12-19, 21, 23-24 and 52 is requested.

Conclusion

In view of the above Remarks, Applicant has addressed all issues raised in the Office Action dated January 9, 2009, and respectfully solicits a Notice of Allowance for claims 1-9, 12-19, 21, 23-24, 52 and 72-74. Should any issues remain, the Examiner is encouraged to telephone the undersigned attorney.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the

amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicant believes that no fees are currently due; however, should any fee be deemed necessary in connection with this Amendment and Response, the Commissioner is authorized to charge deposit account 08-2025, referencing the Attorney docket number 200208339-1.

Respectfully submitted,

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